CASE 33739-US-PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PCT NATIONAL STAGE APPLICATION OF
Heng *et al.*

FILED: October 11, 2006
U.S. APPLICATION NO: 10/599,819
Examiner: COLEMAN, BRENDA LIBBY
Art Unit: 1624

MS Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTARY RESPONSE
REQUEST FOR CONTINUED EXAMINATION

Sir:

In response to the communication mailed August 11, 2010, Applicants submit a request for continued examination together with the following remarks in connection with the above identified application.

The Examiner did not enter the proposed amendments because she is under the opinion that the amendment to the definitions of R1, R2, R3 and R4 including substituted carbonyl and substituted sulfur is not supported and/or contemplated. More specifically, the Examiner indicates that groups like aldehydes, ketones, carboxy, acids, esters, carbonates, amides, thiols, sulfides, thioethers, sulfoxides, sulfones, sulfonates, sulfonamides and the like are not supported and/or not contemplated. Applicants respectfully disagree.

Applicants would like to point out to the Examiner the following examples which support the list of substituents and clearly indicates that the groups cited by the Examiner were contenplated.

Examples 1 and 60: carbonyl substituted with oxy, which is further substituted with alkyl;

Examples 3, 6, 18 and 55d: Carbonyl substituted with alkyl;

Examples 4, 7, 8, 9, 10, 11, 12, 13, 17, 19, 22 and 34: Carbonyl substituted with unsubstituted or substituted amino;

Examples 42 and 16: R1 is Amino substituted with sulfur, which is further substituted with oxo and alkyl;

Examples 15 and 39: R1 is Amino substituted with sulfur, which is further substituted with oxo and amino;

Example 48: carbonyl substituted with heterocyclyl; and

Examples 30, 40, 51, 85, 116, 126, 142, 152: R1 is sulfonamide.

Applicants respectfully disagree that the instant claims are not enabled. The test of enablement is whether one reasonably skilled in the art, following the teaching of the patent specification coupled with information known in the art at the time the patent application was filed, could make or use the invention without undue experimentation. *U.S. v. Telectronics Inc.*, 857 F.2d 778, 8 U.S.P.Q.2d 1217 (Fed. Cir. 1988). Undue experimentation is experimentation that would require a level of ingenuity beyond what is expected from one of ordinary skill in the field. *Field v. Conover*, 170 U.S.P.Q. 276, 279 (C.C.P.A. 1971). *In re Wands*, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988), and *In re Jackson*, 217 U.S.P.Q. 804, 807 (1982).

The law does not require the scope of enablement provided by the specification to mirror precisely the scope of protection sought by the claims. See *In re Fisher*, 166 U.S.P.Q. 18, 24 (C.C.P.A. 1970); see also, *In re Wright*, 27 U.S.P.Q.2d 1510 (Fed. Cir. 1993). To be enabled, all the law requires is that the scope of the enablement provided by the specification bear a "reasonable correlation" to the scope of the claims. *Id.* Moreover, even if evidence to doubt the proposed correlation exist, "the examiner must weigh the evidence for and against the correlation and decide whether one skilled in the art would accept the model as reasonably correlating to the condition". *In re Brana*, 51